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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/872,226	06/01/2001	Darrel D. Cherry	10008157-1	6963

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HEWLETT-PACKARD COMPANY
Intellectual Property Administration
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EXAMINER	
BEKERMANN, MICHAEL	

ART UNIT	PAPER NUMBER
3622	

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
3 MONTHS	01/04/2007	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

Office Action Summary

Application No.

09/872,226

Applicant(s)

CHERRY ET AL.

Examiner

Michael Bekerman

Art Unit

3622

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 03 October 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-24 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-24 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____.

- 4) ☐ Interview Summary-(PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____.

DETAILED ACTION

This action is responsive to papers filed on 10/03/2006.

Claim Objections

1. Claims 14 and 23 are objected to under 37 CFR 1.75(c), as being of improper dependent form for failing to further limit the subject matter of a previous claim. Applicant is required to cancel the claim(s), or amend the claim(s) to place the claim(s) in proper dependent form, or rewrite the claim(s) in independent form. The limitations recited in these claims have been included into the parent claims by amendment, thus making the dependent claims unnecessary.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

2. **Claim 10-18 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.**

Regarding claims 10-18, the first limitation recites "inputting personal information by said user". This limitation points out that the user performs this step. The next limitation recites "obtaining a media request from said user". This limitation points out that the user does not perform this step, yet gives no indication as to who

Art Unit: 3622

actually does. It is unclear in this claim as to which steps are to be performed by the user, which are to be performed by the advertiser, and which are to be performed by the media service. This issue repeats throughout the dependent claims.

Further regarding claim 10, applicant states that this amendment was taken from claim 19. Thus, it makes the claim unclear as these amended steps seem to be out of order with the rest of the original steps in claim 10. It appears that these steps should be performed by the advertiser, and thus, should occur before the "receiving at least one advertisement" step.

Further regarding claim 11, this claim recites the limitation "using said input device". There is insufficient antecedent basis for this limitation in the claim.

Further regarding claim 15, the limitations recite determining a size and location of at least one advertisement, yet this claim limits the step of querying from claim 10. In claim 10, the receiving of the advertisement occurs after the querying. Thus, it is unclear how an advertisement may be analyzed as recited in the claim when it has yet to be received. Examiner rather understands this claim to recite size and location determinations for vacant advertising spaces instead of for the advertisements themselves.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the

Art Unit: 3622

invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claims 1-24 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kent (U.S. Pub No. 2002/0040374) in view of Zehr (U.S. Pub No. 2001/0025274).

Regarding claims 1-4 and 6-8, Kent teaches storing advertisements (Paragraph 0079, Sentence 1) and media selections (Paragraph 0058, Sentence 1), communicating with a remote device (Paragraph 0083, Sentence 1), printing hardcopy media products (Paragraph 0083, Sentence 1), retrieving information from a user (Paragraph 0038, Sentence 1), and displaying lists of available media selections (Paragraph 0038, Last Sentence). Media publisher computers and advertisement providers are inherent in the system. Kent further teaches a user profile database (Paragraph 0031, Sentence 1), a media database (Paragraph 0058, Sentence 1), and an advertisement database ((Paragraph 0012). Kent doesn't specify the advertisement data is also having corresponding bid amounts. Zehr teaches a personalized publication system and method that takes bid amounts into consideration (these bid amounts are inherently stored in relation to the advertisements) (Paragraph 0043, Sentence 1). It would have been obvious to one having ordinary skill in the art at the time the invention was made to auction advertisements in personalized publications. This ensures that advertisers willing to pay higher prices for better placement are accommodated.

Regarding claims 5, 14, 21, and 24, Kent teaches that user demographic information includes user preferences (Paragraph 0038, Sentence 1).

Regarding claims 9 and 11-13, Kent teaches a user as registering (subscribing) with a publication (Abstract). Kent doesn't specify that a user needs to log in or is

Art Unit: 3622

assigned a password to authenticate. Official notice is taken that it is old and well known to be assigned and input log-in identification when giving personal preference information online. Authentication is used by Amazon.com (as well as numerous other online retail sites and publication sites) to store wish lists and user preference information. It would have been obvious to one having ordinary skill in the art at the time the invention was made to assign an identifier to a subscriber and use authentication methods to verify said subscriber. This would allow subscribers to change preference information when needed.

Regarding claims 10, 15, 17-19, 22, and 23, Kent teaches inputting user personal information (Paragraph 0038, Sentence 1), obtaining a media request from a user (subscribing is a request) (Paragraph 0038, Last Sentence), querying at least one advertising provider for an advertisement and receiving the advertisement in electronic form (the advertisements are inherently received from an advertising provider, and since the advertisements are accessed by the optimization program, they are inherently in electronic form) (Paragraph 0079, Sentence 1), and merging the media and the advertisement for the user (Paragraph 0062, Sentences 1-2). It can be argued that Kent does not go into detail about which information is exchanged between the advertiser and the media creation service. Kent also does not specify bidding for advertisements. Zehr teaches receiving advertisement information from a media creation service (logging in to place an order) (Paragraph 0040) and sending an advertisement and bid in electronic form (Paragraph 0040 and 0043). Zehr also teaches the price an advertiser is willing to pay as varying based on size of the

Art Unit: 3622

advertisement, location (position) of the advertisement (Paragraph 0047, Sentence 8), or number of times in which the advertisement is printed (Paragraph 0040). By logging in to place an order, an advertiser is privy to all of the advertising options (information) sent from and determined by the media creation service, and uses these options to determine how much to pay for an advertisement. It would have been obvious to one having ordinary skill in the art at the time the invention was made to combine the advertisement order placement system of Zehr with the system of Kent. This would create an easier interface for advertisers to determine how much to pay for placement of an ad.

Regarding claim 16, Zehr teaches receiving bids for advertisements and selecting a winning bid (Paragraph 0043). Comparing the bids is inherent for selecting a winning bid, and informing the advertising provider of the winning bid is inherent when a bill is sent.

Regarding claim 20, Zehr teaches that the advertisement provider bids up for certain ads to reach certain individuals (Paragraph 0043, Sentence 1).

Conclusion

4. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Michael Bekerman whose telephone number is (571) 272-3256. The examiner can normally be reached on Monday - Friday, 7:30 - 4:00.


If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Eric W. Stamber can be reached on (571) 272-6724. The fax phone

Art Unit: 3622

number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

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JEFFREY D. CARLSON
PRIMARY EXAMINER